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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/607,185

06/26/2003

David L. Patton

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5366

7590

06/06/2006

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EXAMINER

REESE, DAVID C

ART UNIT

PAPER NUMBER

3677

DATE MAILED: 06/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/607,185

Applicant(s)

PATTON ET AL.

Examiner

David C. Reese

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 4-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/18/2006 has been entered. Consequently, the following is the current listing of claims in the instant application:

#### *Status of Claims*

- Claims 1, 4-6 are pending.

#### *Claim Objections*

[1] Claim 4 is objected to because of the following informalities: minor grammatical issue, "at a" should just be "at".

Appropriate correction is required.

#### *Claim Rejections - 35 USC § 103*

[2] The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

[3] Claims 1, 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith, US-6,187,213 in view of case law and further in view of applicant's own disclosure.

Although the invention is not identically disclosed or described as set forth 35 U.S.C. 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a designer having ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

As for Claim 1, Smith discloses: a gemstone having a micro-discrete indicia formed thereon wherein said micro-discrete indicia image was formed using optics (Col.1, Ln. 57-67; Col.2, Ln. 1-20), wherein said micro-discrete indicia image has a length no greater than about 10 microns (Col. 3, Ln. 12-17; Coil.4, Ln. 60-65; Col. 5, Ln. 1-5; Col. 10, Ln. 59; the character line is interpreted as the indicia, as opposed to the whole character) and a height no greater than about 2 microns.

The difference between the claim and Smith is the claim recites: using near-field optics, and having an altered color at the location of said micro-discrete indicia. First and foremost, the use of near field optics to make the image is a process step in a product claim and holds little patentable weight. The determination of patentability in a product-by-process claim is based on the product itself, even though the claim may be limited and defined by the process. That is, the product in such a claim is unpatentable if it is the same as or obvious from the product of the prior art, even if the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985). A product-by-process limitation adds no patentable distinction to the claim, and is unpatentable if the claimed product is the same as a product of the prior art. A comparison of the recited process with the prior art processes does NOT serve to resolve the issue concerning patentability of the product. *In re Fessman*, 489 F2d 742, 180

*USPQ 324 (CCPA 1974)*. Whether a product is patentable depends on whether it is known in the art or it is obvious, and is not governed by whether the process by which it is made is patentable. *In re Klug*, 333 F.2d 905, 142 USPQ 161 (CCPA 1964).

Secondly, to reiterate the patentable weight concerning the size of the indicia, the court has held that a change in the size of a prior art device is a design consideration within the skill of the art. Note that those of ordinary skill in the art would appreciate that a modification such as a mere change in size of a component would be obvious. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). See also, MPEP § 2144.04 which states: *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976) ("mere scaling up of a prior art process capable of being scaled up, if such were the case, would not establish patentability in a claim to an old process so scaled." 531 F.2d at 1053, 189 USPQ at 148.). In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device. Therefore, it would have been obvious to change the size of the prior art image. Additionally, the Applicant is reminded that where the only difference between a prior art product and a claimed product is printed matter that is not functionally related to the product, the content of the printed matter will not distinguish the claimed product from the prior art. In *re Ngai*, \_\_\_F.3d\_\_\_, 2004 WL 1068957 (Fed. Cir. May 13, 2004)(Claim at issue was a kit requiring instructions and a buffer agent. The federal Circuit held that the claim was anticipated by a prior

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art reference that taught a kit that included instructions and a buffer agent, even though the content of the instructions differed.) Se also In re Gulack, 703 F.2d 1381, 1385-86, 217 USPQ 401, 4 04 (Fed. Cir. 1983)(“Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability...[T]he critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate.”).

Lastly, with regard to the gemstone having an altered color at the location of said micro-discrete indicia, the applicant states in the disclosure that: “It is also possible to alter the color of gemstone materials as a result of the laser light beam affecting the defect concentration in the gemstone or diamond material. **It is known to those skilled** in the defect physics of such materials that either through direct light absorption into existing defect optical absorption bands or through multi-photon absorption processes, color center can be produced in these materials.”

Re: Claim 4, Smith discloses: wherein in said micro-discrete indicia is provided at a predetermined coordinates on said gemstone.

Re: Claim 5, Smith discloses: wherein said micro-discrete indicia provides information with regard to said gemstone. (Where the only difference between a prior art product and a claimed product is printed matter that is not functionally related to the product, the content of the printed matter will not distinguish the claimed product from the prior art. In re Ngai, \_\_\_F.3d\_\_\_, 2004 WL 1068957 (Fed. Cir. May 13, 2004)(Claim at issue was a kit requiring instructions and a buffer agent. The federal Circuit held that the claim was anticipated by a prior art reference that taught a kit that included instructions and a buffer agent, even though the content of the instructions differed.) Se also In re Gulack, 703 F.2d 1381, 1385-86, 217 USPQ 401, 4 04 (Fed.

Cir. 1983)(“Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability...[T]he critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate.”).

Re: Claim 6, wherein said information comprises any of the following:

size, type, manufacturer, retailer, owner, producer, country of origin, mine. (Where the only difference between a prior art product and a claimed product is printed matter that is not functionally related to the product, the content of the printed matter will not distinguish the claimed product from the prior art. In re Ngai, \_\_\_F.3d\_\_\_, 2004 WL 1068957 (Fed. Cir. May 13, 2004)(Claim at issue was a kit requiring instructions and a buffer agent. The federal Circuit held that the claim was anticipated by a prior art reference that taught a kit that included instructions and a buffer agent, even though the content of the instructions differed.) See also In re Gulack, 703 F.2d 1381, 1385-86, 217 USPQ 401, 404 (Fed. Cir. 1983)(“Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability...[T]he critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate.”).

***Response to Arguments***

[4] To begin, the examiner would like to point out that it is the claims that define the claimed invention, and it is claims, not specifications that are anticipated or unpatentable. *Constant v. Advanced Micro-Devices Inc.*, 7 USPQ2d 1064. Thus, the fact that Smith may or may not teach at least micro-discrete indicia formed using near-field optics is irrelevant so long as Smith teaches of at least micro-discrete indicia. The statement “using near-field optics” is given no patentable weight since, as discussed above, the determination of patentability in a product-by-process claim is based on the product itself, even though the claim may be limited and defined by the process. That is, the product in such a claim is unpatentable if it is the same as or obvious from the product of the prior art, even if the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985). A product-by-process limitation adds no patentable distinction to the claim, and is unpatentable if the claimed product is the same as a product of the prior art. A comparison of the recited process with the prior art processes does NOT serve to resolve the issue concerning patentability of the product. *In re Fessman*, 489 F2d 742, 180 USPQ 324 (CCPA 1974). Whether a product is patentable depends on whether it is known in the art or it is obvious, and is not governed by whether the process by which it is made is patentable. *In re Klug*, 333 F.2d 905, 142 USPQ 161 (CCPA 1964). In an ex parte case, product by process claims are not construed as being limited to the product formed by the specific process recited. *In re Hirao et al.*, 535 F.2d 67, 190 USPQ 15, see footnote 3 (CCPA 1976).

Continuing, the applicant refutes the office actions assertion that “one of ordinary skill in the art would appreciate that a modification such as a mere change in size of a component would



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be obvious.” The examiner maintains that a prima facie case of obviousness has already been provided and does not necessarily have to be suggested by the prior art to be considered an obvious alteration. Rather, in the instant case, the test of changing the size or shape of an aspect of a prior art device is versed when the prior art is taken as a whole and what would suggest to one of ordinary skill in the art. It is important to keep in mind that when one does not contemplate the aspect of the process in the instant case, that is, when the fact that near-field optics is given no patentable weight, the only difference between the prior art and the instant invention is a mere change in size of the invention. With that said, once again, in *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

Finally, the applicant refutes the examiner’s assertion “that the printed matter is not functionally related to the product.” The question in the instant case is not whether or not printed matter can be considered patentable, but whether the difference in content of the printed matter between the prior art and the instant invention is patentable. Case law has taught us that this not the case, that is, the content of the printed matter will not distinguish the claimed product from the prior art. In re Ngai, \_\_F.3d\_\_, 2004 WL 1068957 (Fed. Cir. May 13, 2004).

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***Conclusion***


[5] Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Reese whose telephone number is (571) 272-7082. The examiner can normally be reached on 7:30 am-6:00 pm Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J.J. Swann can be reached at (571) 272-7075. The fax number for the organization where this application or proceeding is assigned is the following: (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David Reese  
Assistant Examiner  
Art Unit 3677

DCR



5/24/06



ROBERT J. SANDY  
PRIMARY EXAMINER